

**REMARKS**

Claims 1, 2, and 4-31 are pending and under consideration. Claim 3 has been cancelled herein without prejudice or disclaimer. Claims 1, 2, 4-20, and 23-29 have been amended herein. New claims 30 and 31 have been added herein. Support for the amendments to the claims may be found in the specification and claims as filed originally, and, in particular, in claim 3. Support for the new claims may be found in the specification and claims as originally filed. The amendments are made strictly in the interest of compact patent prosecution and not for any reasons of patentability. Reconsideration is requested based on the foregoing amendment and the following remarks.

**Priority:**

This application claims priority to Japanese Patent Application No. 2001-00641, filed January 5, 2001 under 35 U.S.C. § 119(a). 37 C.F.R. § 1.78(a), on the other hand, applies to (1) prior-filed copending nonprovisional applications or international applications designating the United States of America that are either (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or (ii) Complete as set forth in § 1.51(b); or (iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or (iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f). The requirements of 37 C.F.R. § 1.78(a)(2) and (a)(5) are thus believed to be inapplicable.

**Objections to the Claims:**

Claims 1, 2, and 4-29 were objected to for various informalities. Claims 1, 2, 4-20, and 23-29 were amended in substantial accord with the Examiner's suggestions. The Examiner's suggestions are appreciated. Withdrawal of the objection is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 112:**

Claims 5, 9, 10, 11, 16, 18, 22, 23, 24, and 26 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 5, 9, 10, 11, 16, 18, 23, 24, and 26 were amended to make them more definite. Withdrawal of the rejection is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 102:**

Claims 1, 4, 6, 7, 8, 14, 17, 20, and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by Mani et al. "Identifying Unknown Proper Names in Newswire Text," (hereinafter "Mani"). The rejection is traversed to the extent it would apply to the claims as amended.

Claim 1 recites,

"an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold."

Mani neither teaches, discloses, nor suggests "an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," as recited in claim 1. Mani, rather, is concerned strictly with identifying unknown proper names for information retrieval or as a precursor for more knowledge intensive tasks such as data extraction, as described in the Abstract. Making names anonymous after identifying them for data extraction purposes would have served no purpose for Mani. The Office Action, in fact, acknowledges that Mani teaches no anonymity setting processing unit which rewrites, i.e. changes a person's name having a specificity which is greater than a predetermined threshold at paragraph 8 on page 6.

Claim 1 recites further,

"wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions."

Mani neither teaches, discloses, nor suggests "wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions," as recited in claim 1.

Claim 1 recites further,

"said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name."

Mani neither teaches, discloses, nor suggests "said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a

predetermined threshold, anonymity for such surrounding expression and the person's name," as recited in claim 1.

Finally, to serve as an anticipating reference, the reference must enable that which it is asserted to anticipate. "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CA FC 2003).

Mani, here, would not constitute an enabling disclosure if it were an application for a patent. Mani, in particular, is essentially a survey or an overview of work that was done previously, or so the authors claim, without describing how to make and use the invention, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, as required by 35 U.S.C. § 112. As one example of the deficiencies of Mani with respect to the enablement requirement, the algorithm described at section 3 is provided nowhere. Since Mani does not enable the claimed invention, Mani cannot anticipate the claimed invention. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 4, 6, 7, and 8 depend from claim 1 and add further distinguishing elements. Claims 4, 6, 7, and 8 are thus also submitted to be allowable. Withdrawal of the rejection of claims 4, 6, 7, and 8 is also earnestly solicited.

Claims 14, 17, 20, and 21:

Claim 14 recites,

"an anonymity setting processing step of rewriting the name of the person with an anonymity expression in said input document which has a specificity higher than a predetermined threshold."

Mani neither teaches, discloses, nor suggests "an anonymity setting processing step of rewriting the name of the person with an anonymity expression in said input document which has

a specificity higher than a predetermined threshold," as discussed above with respect to the rejection of claim 1.

Claim 14 recites further,

"wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of intensity at which the person can be specified with the extracted individual surrounding expressions."

Mani neither teaches, discloses, nor suggests "wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of intensity at which the person can be specified with the extracted individual surrounding expressions," as discussed above with respect to the rejection of claim 1.

Claim 14 recites further,

"said anonymity setting processing step sets, when there is a surrounding expressions of a degree of specificity higher then a predetermined threshold, anonymity for said surrounding expression and the person's name."

Mani neither teaches, discloses, nor suggests "said anonymity setting processing step sets, when there is a surrounding expressions of a degree of specificity higher then a predetermined threshold, anonymity for said surrounding expression and the person's name," as discussed above with respect to the rejection of claim 1.

Finally, Mani is not an enabling reference, as discussed above with respect to the rejection of claim 1. Claim 14 is submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 14 is earnestly solicited.

Claims 17, 20, and 21 depend from claim 14 and add further distinguishing elements. Claims 17, 20, and 21 are thus also submitted to be allowable. Withdrawal of the rejection of claims 17, 20, and 21 is also earnestly solicited.

#### **Claim Rejections - 35 U.S.C. § 103:**

Claims 2, 12, 13, 15, 25, 27, 28, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mani in view of Rubin *et al.* US 6,654,724 (hereinafter "Rubin"). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 2, 12, and 13 depend from claim 1 and add further distinguishing elements. Mani neither teaches, discloses, nor suggests “an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold,” “wherein said specificity calculating unit extracts surrounding expressions of the person’s name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions,” or “said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person’s name,” as discussed above with respect to the rejection of claim 1.

Rubin does not either, and thus cannot make up for the deficiencies of Mani with respect to claims 2, 12, and 13. In Rubin, rather, the name of the patient for whom anonymity is desired is already known, as described at column 7, lines 56-59, and shown in Table I. There is no need to worry about how specifically the person has been identified, there is no doubt as to their identity. Thus, even if Mani and Rubin were combined, as proposed in the Office Action, the claimed invention would not result. Claims 2, 12, and 13 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2, 12, and 13 is also earnestly solicited.

Claims 15, 25, 27, 28:

Claims 15, 25, 27, 28 depend from claim 14 and add further distinguishing elements. Mani neither teaches, discloses, nor suggests “an anonymity setting processing step of rewriting the name of the person with an anonymity expression in said input document which has a specificity higher than a predetermined threshold,” “wherein said specificity calculating step extracts surrounding expressions of the person’s name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of intensity at which the person can be specified with the extracted individual surrounding expressions,” or “said anonymity setting processing step sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for said surrounding expression and the person’s name,” as discussed above with respect to the rejection of claim 14.

Rubin does not either, and thus cannot make up for the deficiencies of Mani with respect to claims 15, 25, 27, and 28. In Rubin, rather, the name of the patient for whom anonymity is desired is already known, as described at column 7, lines 56-59, and shown in Table I. There is no need to worry about how specifically the person has been identified, there is no doubt as to

their identity. Thus, even if Mani and Rubin were combined, as proposed in the Office Action, the claimed invention would not result. Claims 15, 25, 27, and 28 are thus also submitted to be allowable. Withdrawal of the rejection of claims 15, 25, 27, and 28 is also earnestly solicited.

Claim 29:

Claim 29 recites,

"an anonymity setting processing step of rewriting the person's name with an anonymity expression in said input document which has a higher specificity than a predetermined threshold."

Neither Mani nor Rubin teach, disclose, or suggest "an anonymity setting processing step of rewriting the person's name with an anonymity expression in said input document which has a higher specificity than a predetermined threshold," as discussed above with respect to the rejections of claims 2, 12, 13, 15, 25, 27, and 28.

Claim 29 recites further,

"wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating at what degree of intensity the person can be specified with the extracted individual surrounding expressions."

Neither Mani nor Rubin teach, disclose, or suggest "wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating at what degree of intensity the person can be specified with the extracted individual surrounding expressions," as discussed above with respect to the rejections of claims 2, 12, 13, 15, 25, 27, and 28.

Finally, claim 29 recites,

"said anonymity setting processing step sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and person's name."

Neither Mani nor Rubin teach, disclose, or suggest "said anonymity setting processing step sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and person's name," as discussed above with respect to the rejections of claims 2, 12, 13, 15, 25, 27, and 28. Thus, even if Mani and Rubin were combined, as proposed in the Office Action, the claimed invention

would not result. Claim 29 is submitted to be allowable as well, for at least those reasons as discussed above with respect to the rejections of claims 2, 12, 13, 15, 25, 27, and 28. Withdrawal of the rejection of claim 29 is earnestly solicited.

**New Claims:**

New claim 30:

New claim 30 depends from claim 29 and adds further distinguishing elements. New claim 30 is thus also believed to be allowable.

New claim 31:

New claim 31 recites,

"rewriting the expression with an anonymous expression if the degree of specificity is greater than a predetermined threshold."

None of the cited references teach, disclose, nor suggest "rewriting the expression with an anonymous expression if the degree of specificity is greater than a predetermined threshold," as discussed above. New claim 31 is thus also believed to be allowable.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 2, and 4-31 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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